

REMARKS

Reconsideration and withdrawal of the rejections of the application is respectfully requested in view of the remarks and enclosures herein. The Examiner is thanked for the withdrawal of the rejection of the claims under 35 U.S.C. §103(a) as being unpatentable over Gurian in view of Robinson.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 15-17, 19-21 and 23-28 are now pending. New claims 26-28 have been added, without prejudice, without admission, without surrender of subject matter, and without any intention of creating any estoppel as to equivalents.

No new matter is added.

It is submitted that these claims are and were in full compliance with the requirements of 35 U.S.C §112. In addition, the amendment and remarks herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §§101, 102, 103 or 112; but rather the amendments and remarks herein are made simply for clarification and to round out the scope of protection to which Applicant is entitled. Support for the amended claims is found throughout the specification, specifically on page 18, lines 9-15.

II. THE ART REJECTIONS ARE OVERCOME

Claims 15-17, 19 and 23 were again rejected under 35 U.S.C. §102(b) as allegedly anticipated by Gurian (U.S. 5,865,005). Claims 15-16, 19 and 23 were again rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Clarke (U.S. 6,258,455). And, the rejection of claims 20-21 and 24 under 35 U.S.C. §103(a) as being allegedly unpatentable over Clarke in view of Newman (U.S. 6,000,057) was also maintained. The rejections are respectfully traversed and will be addressed in turn.

Applicant respectfully reminds the Examiner that a two-prong inquiry must be satisfied in order for a Section 102 rejection to stand. First, the prior art reference must contain all of the elements of the claimed invention. *See Lewmar Marine Inc. v. Barient Inc.*, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Second, the prior art must contain an enabling disclosure of the claimed invention. *See Chester v. Miller*, 15 U.S.P.Q.2d 1333, 1336 (Fed. Cir. 1990). Applicant respectfully maintains that Gurian fails both prongs of this test.

The Office Action admits that Gurian fails to disclose that the fabric can be an odor-reducing fabric but states that Gurian meets all of the claimed structural and/or chemical limitations. Applicant respectfully disagrees and maintains that Gurian relates to an anti-microbial and permanently flame-retardant fabric that would lose its required flame retardant properties if it were to encompass the at least 25% by weight acetate that is required by the present invention. Accordingly, Gurian cannot be enabled for a fabric containing at least 25% by weight acetate as such a high percentage of acetate would prevent the fabric from retaining the flame-retardant properties required by Gurian.

In response to Applicant's arguments regarding the loss of flame-retardant properties that would accompany an increase in the amount of acetate in Gurian's fabric, the Office Action maintains that such loss of required properties is mere conjecture on the part of the Applicant without any reliance on supporting facts.

Applicant respectfully disagrees, and again draws the Examiner's attention to the specification of Gurian, wherein two different fabrics are exemplified, wherein the fabrics were comprised of 94% fire-retardant polyester and **6% anti-microbial acetate** or 91% flame-retardant polyester and **9% anti-microbial acetate** (column 5, lines 51-53 and column 6, lines 3-5 and lines 16-18). Nowhere in Gurian is it taught that the fabric of Gurian could be made with a significantly higher percentage of acetate (for example at least 25%) such that the fabric would maintain its flame-retardant properties.

In support of this, the Examiner is invited to again review "Textile Guru" by Celeste Pennington, which was provided as Exhibit 2 of the June 28, 2004 Response.

"Textile Guru" describes Gurian's experiences in designing the fabric that is believed described in the Gurian patent, namely a fabric that combines MicroSafe and Trevira to provide an anti-microbial, flame-retardant fabric. To develop the fabric of the Gurian patent, "DesignTex developed and tested a wide range of blend levels." A large amount of experimentation was necessary to arrive at the fabric, and according to Gurian, "[he] kept working with the two fibers by blending them in new air-textured yarns that finally resulted in killing 90 percent-plus of the staph and pneumonia, yet passing the flammability test." Such high levels of experimentation was necessary because combining "MicroSafe and Trevira in a way that would preserve the properties of each was a challenge because the two are contradictory in terms of flammability and bacteria resistance."

This statement supports Applicant's position that MicroSafe, while providing anti-microbial capabilities, is highly flammable, and would therefore require much experimentation to incorporate such a highly flammable material into a fabric that is required to retain flame-retardant properties.

Further support of Applicant's position is found in the fact that despite the "wide range of blend levels" developed and tested by DesignTex, in **no instance** does DesignTex manufacture or sell a flame-resistant and anti-microbial fabric that contains **more than 11% acetate** (see Cubicle and Drapery specification, submitted on June 28, 2004 as Exhibit 3). As the article by Pennington describes the difficulty that DesignTex encountered when developing the fabric of Gurian, the fact that DesignTex uses no more than 11% acetate in their flame-retardant fabric and that Gurian's examples similarly use only 6% or 9% acetate supports Applicant's contention that Gurian's fabric, if made using at least 25% acetate, would not retain the properties of Gurian. The process of experimentation that was undertaken by DesignTex and Gurian was intended to develop an anti-microbial and flame-retardant fabric. After developing and testing a "wide range of blend levels", the fact that DesignTex had much difficulty in determining the proper blend and now manufactures and sells only fabrics containing no more than 11% acetate demonstrates that those fabrics made with blends using more than 11% acetate were faulty and did not retain the required properties, namely being both anti-microbial and flame-retardant.

Accordingly, as Gurian's own words lend support to the Applicant's contention that a fabric containing at least 25% by weight acetate would not retain its flame-retardant properties, Applicant again asserts that Gurian is not enabled for an anti-microbial, flame-retardant fabric having at least 25% by weight acetate.

Furthermore, it is respectfully asserted that as Gurian's fabric contains a much lower amount of antimicrobial acetate than does the present invention, Gurian's fabric would not provide the significant odor reduction of the present invention. Gurian's fabric is considered antimicrobial only in relation to *staphylococcus* and *pneumonia*. In contrast, the present invention is successful in significantly reducing odors from humans, an act that is significantly different than providing a surface for use in a hospital which is antimicrobial.

For example, on skin, much of the bacterial flora is located in the openings of hair follicles with a majority of the bacterial flora present in moist areas of the skin. In such areas, the typical native flora of skin includes *Propionibacterium acnes*, *Staphylococcus epidermidis*, *S.*

aureus and *Corynebacterium spp.* As the flora of the skin are different from that which the fabric of Gurian is intended to inhibit, it cannot be considered inherent that the fabric of Gurian would inhibit odor from human as does the present invention. For this reason too, therefore, Gurian does not satisfy all of the elements of the present invention and does not contain an enabling disclosure.

Again, for a rejection under section 102 to stand, the cited reference must contain all of the elements of the claim, and it must have an enabling disclosure. Therefore, as Gurian does not provide an enabling disclosure, it is respectfully submitted that the rejection over Gurian cannot stand.

Consequently, for all of the reasons set forth above, reconsideration and withdrawal of the rejection under 35 U.S.C. §102(b) based on Gurian is respectfully requested.

Turning to the Section 103 rejections over Clarke alone or in combination with Newman, Applicant again respectfully submits that the rejections are improper.

The Examiner respectfully reminded that for a Section 103 rejection to be proper, there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the reference teachings to arrive at the claimed invention. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (BOPAI 1993). Further, the Examiner is respectfully reminded that “obvious to try” is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.” Also, the Examiner is additionally respectfully reminded that for the Section 103 rejection to be proper, **both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants’ disclosure.** *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

Furthermore, the Examiner is also respectfully reminded that MPEP 2143.01 mandates that for a Section 103 rejection, there must be some suggestion or motivation to modify reference teachings, and, that MPEP 2143.02 further mandates that for a section 103 rejection, there must be a reasonable expectation of success.

Clarke relates to an antimicrobial material having at least one yarn having fine fiber of 1.0 denier or less, wherein the material is to be used for cleaning. Applicant again respectfully submits that Clarke, in requiring the use of microfibers in the material, inherently provides a material that would not be suitable for use in the present invention. Therefore, one of skill in the art would have no motivation to modify Clarke to arrive at the present invention.

As stated in the Response filed June 28, 2004, microfibers have unique characteristics that are not shared by larger fibers, and vice versa. Microfibers provide an extremely absorbant material which has a soft and silky feel. These fibers would not be useful in the present invention, where the use as a hunting garment requires a fabric that will not be highly absorbant and wherein strength and stability will be of great importance. There would be no motivation for one of skill in the art to attempt to adapt the microfiber cloth of Clarke, either alone or in combination with any other references, into a rugged fabric for use in hunting garments and related materials. Furthermore, nowhere in Clarke is there any suggestion of success for the modification of the material therein into the fabric of the present invention. Clarke discusses its material's suitability for use in mops, dishcloths, towels, diapers, hygiene products, etc. All of these items are so far removed from the scope of the present invention, namely hunting garments, that one of skill in the art would not be able to contemplate the use of Clarke's material for such a purpose.

Applicant respectfully submits that neither is there any motivation for the combination of Newman and Clarke, nor is there a likelihood of success indicated by either reference.

Newman describes and claims "hunting apparel comprising an article of clothing constructed with an inner layer of an antimicrobial fabric and outer layer of an odor-absorbing material." The Office Action maintains that because the material of Clarke is "suitable for a variety of applications and comprises antimicrobial fibers" it would be obvious to use the material of Clarke in the hunting apparel of Newman. Applicant again respectfully disagrees.

Again, as Clarke relates to a material made of microfibers, one of skill in the art would have no motivation to use such a material in Newman's hunting apparel which inherently requires a fabric having a strength and structure that would not be possible using microfibers. Furthermore, as previously discussed, Newman appears to maintain that his patent covers the Contain™ line of clothing. Applicant will be submitting under separate cover a Declaration by the inventor that describes the results of comparative tests between the fabric of the present

invention, traditional fabric, and that of the Contain™ line. In all tests, the fabric of the present invention greatly reduced the odor emitted when compared to the alleged Newman fabric and to a traditional fabric. Accordingly, not only is there no motivation to utilize the material of Clarke in the apparel of Newman, the present invention provides significantly surprising and superior results over the fabric of Newman.

Consequently, one would not be motivated to combine Clarke and Newman, and even if one did, the combination would not result in the superior fabric of the present invention. Therefore, reconsideration and withdrawal of the Section 103 rejection over Clarke in view of Newman is respectfully requested.

REQUEST FOR INTERVIEW

If any issue remains as an impediment to allowance, prior to issuance of any paper other than a Notice of Allowance, an interview, is respectfully requested, with the Examiner and his supervisor, and, the Examiner is respectfully requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview.


CONCLUSION

In view of the remarks herewith and those of record, the application is in condition for allowance. Favorable reconsideration of the rejections of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date.

Respectfully submitted,

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